

REMARKS/ARGUMENTS

Responsive to the Office Action mailed June 3, 2004:

I. PRIOR ART MATTERS

- A. The Office Action rejected claims 1-31 under 35 USC 103(a) as being unpatentable over Compton in view of Tso. Applicant respectfully traverses the rejection.

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.¹ If the Examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of non-obviousness.²

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.³

Applicant respectfully traverses the § 103 rejection because the office action has not established a *prima facie* case of obviousness.

The references do not teach or suggest all the claim limitations.

As to claim 1, the references do not teach the claimed steps b), d), and e). Specifically, Compton, the primary reference, does all source reading and compression at a central location, not the user's remote location, as claimed. See Compton cols. 3-6 and Figs. 1-3. Particularly note that Fig. 1 shows the "Video Source" 14 as being at a different location (presumably the central location of the central processing system 16) from the end user 28. This is a vital difference, as the claimed invention allows the user to capture and compress selected tracks of digital content using the user's own system, and then transmit the compressed content to a central location. The

¹MPEP Sec. 2142.

²Id.

³Id. (emphasis supplied)

user is thus the owner of the digital media from which the selected tracks are compressed, not the central location. The user has complete control over which portion of his digital media library that he wishes to transmit to the central location for storage. This is not possible with the cited references. Furthermore, as explained at page 5 of the Specification, the user has the ability to compress any track obtained from other lawful sources. Again, this is not possible with the cited references.

Furthermore, the cited references do not disclose the capability of the user to specify only certain tracks for compression.

Claim 1 is therefore allowable.


Claims 2-11 contain additional elements or limitations beyond allowable claim 1 and are also allowable.

Claims 12-31 are allowable for similar reasons.

For the above reasons, Applicant respectfully requests the allowance of all claims and the issuance of a Notice of Allowance.

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page is captioned Version With Markings to Show Changes Made.

Respectfully submitted,

By 
Gerald E. Helget (Reg. No. 30,948)
Nelson R. Capes (Reg. No. 37,106)
Briggs & Morgan P.A.
80 South Eighth Street
2200 IDS Center
Minneapolis, MN 55402
Telephone: (612) 977-8480

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE SPECIFICATION:

Please replace the paragraph beginning at page 3, line 3, with the following rewritten paragraph:

--Since the Internet provides the foundation to move such digital content across the world in a fraction of a [section] second, one can now understand the power of such commerce. It is clearly obvious that the Internet could have a tremendous impact on industries creating and managing such digital content. Music and video industries are scrambling to capitalize on many opportunities the Internet offers but at the same time they drag their feet allowing digital distribution of music and video. They fear to lose control over their digital content to piracy and unauthorized content distribution to millions of people worldwide without compensation.

Please replace the paragraph beginning at page 5, line 1 with the following rewritten paragraph:

--selecting a compression scheme and conveniently storing all compressed tracks for future use. Users will also be able to compare the quality of each compression scheme for different types of music. For the first time an Internet user may elect to compress any track from original CDs, use the preferred compression scheme, and store the compressed track outside of his/her computer via a single application offered in the website.

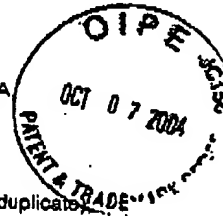
1694969v1

BEST AVAILABLE COPY

OCT 15 2004

Receipt is hereby acknowledged by the Commissioner for Patents in the U.S. Patent & Trademark Office of the following items in Briggs & Morgan P.A. File No. 33046.23 and for the Amendment and Response that is filed herewith:

First Name Inventor: Marco Scibora
Application No.: 09/759,798
Filing Date: January 12, 2001
Title: COMPRESSION AND REMOTE
STORAGE APPARATUS FOR DATA
MUSIC AND VIDEO



1. Transmittal Cover Letter (1 page);
2. Fee Transmittal FY 2004 (1 page);
3. Petition for Extension of Time under 1.136(a)(1 page)(in duplicate);
4. Check in the amount of \$55.00 (Extension fee); and
5. Amendment and Response (5 pages).

SENT VIA FIRST CLASS MAIL

NRC:jsk

35249.27

October 4, 2004